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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,842	03/28/2000	David W. Miller	99-082-TAP	5069

7590 11/16/2004  
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EXAMINER

RAO, SHEELA S

ART UNIT PAPER NUMBER

2125

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/535,842

Applicant(s)

MILLER ET AL.

Examiner

Sheela Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Applicant's amendment filed along with the request for RCE on 23 August 2004 has been entered and considered.
2. Claims 1-21 are present in the application. Claims 1, 10, and 17 have been amended. Claims 1-21 are pending and presented for examination.

***Response to Amendment***

3. The rejection of claims 1-21 as being unpatentable over Miyoshi, et al. (USP 5,646,917) in view of Heidelberg, et al. (USPN 5,486,727) is **maintained** and restated below.

Miyoshi, et al. discloses a device for stocking a plurality of CDs wherein a horizontal carrier or robotic element is used to be moved along guide rails of the frame of the stocking device or library. The library system of the patented invention comprises a plurality of openings for storing discs, also a guide rail is provided so that the carrier can slide to carry the discs to their respective slots. See figure 1. Miyoshi also teaches the use of a plurality of coils positioned equidistantly within the proximity of the rails. With regard to claims 1-4, see column 3: lines 29-52.

The prior art further teaches the use of magnetic forces to move the carrier or robotic element between the guide rails, as per the limitations of instant claims 10-15. See column 3: line 64 to column 4: line 34.

As per the last paragraph of instant claim 1 and the limitations set forth by instant claims 5-9 and 16-21, Miyoshi, et al. does not teach the use of a secondary coil to inductively couple for powering the drive mechanism. The drive mechanism of the horizontal carrier or robot as taught by Miyoshi comprises a magnet which when combined with the primary coils, within the guide rails, powers the movement of the unit. The reference of prior art to Heidelberg, et al. teaches the use of multiple coils which produces and allows for the flow of a magnetic field. Furthermore, the reference teaches that coils would be a probable and possible replacement for magnets since magnets tend to slow down movement and acceleration since they have a higher mass compared to that of coils. Over time, magnets tend to produce relatively

weaker fields thereby loosing their productive potential. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated multiple coils for powering the drive mechanism of the carrier stocker system of Miyoshi, et al. so as to maintain and improve efficiency, as well as to reduce weight and expenses. See Heidelberg, et al., column 2: lines 33-48.

For the reasons stated above, the limitations of the claimed invention are taught by the prior arts of record; thereby, rendering the instant claims unpatentable.

#### ***Response to Arguments***

4. Applicant's arguments filed August 23, 2004 have been fully considered but they are not persuasive.

Applicants have not provided any persuasive arguments regarding the references of prior art that has been applied to the limitations of the instant claims. The remarks that Applicant has made, beginning on page 8 of the response filed, do not provide any basis for which to withdraw the rejection made under 35 USC §103(a) to claims 1-21. Paragraph 3 on page 8 merely describes the claims with regard to the elements of the instant invention and paragraph 4 on page 8 continuing on page 9 only conveys the teachings of the patented references over which the claims have been rejected. Paragraph 5 on page 9 makes general allegations of what the references do not teach but does not make any specific statements as to what has not been taught or fairly suggested by the applied references. Paragraph 5 is a conclusory statement regarding the 35 USC §103(a) rejection. No reference or guidance as to what aspect or element of the claim language is lacking in the prior arts of reference has been provided. Furthermore, no particular portion or limitation of the claim language has been cited as not having been taught or fairly suggested. Paragraph 6 on page 9 is no different from the aforementioned paragraphs in citing any perceived deficiencies with regard to the references based on the claimed limitations. Paragraph 6 is a simplified explanation of what is set forth by instant claim 10.

Upon consideration of Applicant's remarks as such, the Examiner is unable to withdraw the rejection of claims 1-21 as being unpatentable over Miyoshi et al. (USPN 5,646,917) in view of Heidelberg

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et al. (USPN 5,486,727) under the statutes of 35 USC §103(a) nor is she convinced that the instant claims are allowable over the prior arts of record.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela Rao whose telephone number is (571) 272-3751. The examiner can normally be reached Tuesday - Thursday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749.


Any response to this action should be mailed to:

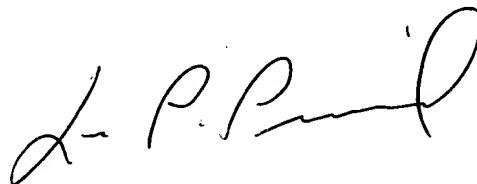
**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

**(703) 305-3718 for Official Communications**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Sheela S. Rao  
November 10, 2004



**LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**